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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,842	03/28/2000	David W. Miller	99-082-TAP	5069

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EXAMINER

RAO, SHEELA S

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

**Application No.**

09/535,842

**Applicant(s)**

MILLER ET AL.

**Examiner**

Sheela Rao

**Art Unit**

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendment/response filed 11 February 2004 has been entered and considered.
2. Claims 1-21 are presented for examination. No amendments have been made to the instant claims.

***Response to Amendment***

3. The rejection of claims 1-21 as being unpatentable over Miyoshi, et al. (USP 5,646,917) in view of Heidelberg, et al. (UUSPN 5,486,727) is **maintained** and restated below.

Miyoshi, et al. discloses a device for stocking a plurality of CDs wherein a horizontal carrier or robotic element is used to be moved along guide rails of the frame of the stocking device or library. The library system of the patented invention comprises a plurality of openings for storing discs, also a guide rail is provided so that the carrier can slide to carry the discs to their respective slots. See figure 1. Miyoshi also teaches the use of a plurality of coils positioned equidistantly within the proximity of the rails. With regard to claims 1-4, see column 3: lines 29-52.

The prior art further teaches the use of magnetic forces to move the carrier or robotic element between the guide rails, as per the limitations of instant claims 10-15. See column 3: line 64 to column 4: line 34.

As per the last paragraph of instant claim 1 and the limitations set forth by instant claims 5-9 and 16-21, Miyoshi, et al. does not teach the use of a secondary coil to inductively couple for powering the drive mechanism. The drive mechanism of the horizontal carrier or robot as taught by Miyoshi comprises a magnet which when combined with the primary coils, within the guide rails, powers the movement of the unit. The reference of prior art to Heidelberg, et al. teaches the use of multiple coils which produces and allows for the flow of a magnetic field. Furthermore, the reference teaches that coils would be a probable and possible replacement for magnets since magnets tend to slow down movement and acceleration since they have a higher mass compared to that of coils. Over time, magnets tend to produce relatively weaker fields thereby loosing their productive potential. It would have been obvious to one of ordinary skill

in the art at the time the invention was made to have incorporated multiple coils for powering the drive mechanism of the carrier stocker system of Miyoshi, et al. so as to maintain and improve efficiency, as well as to reduce weight and expenses. See Heidelberg, et al., column 2: lines 33-48.

For the reasons stated above, the limitations of the claimed invention are taught by the prior arts of record; thereby, rendering the instant claims unpatentable.

#### ***Response to Arguments***

4. Applicant's arguments filed 11 February 2004 have been fully considered but they are not persuasive.

Applicant argues that the references of prior art do not teach or suggest the limitations of the instant invention. Examiner disagrees. The patented inventions of Miyoshi and Heidelberg, alone or in combination, sufficiently teach/suggest the limitations of the instant invention to the extent claimed. Applicant states "Miyoshi teaches a magnetic force to move the carrier ... ." Examiner agrees that Miyoshi does in fact teach the use of magnetic forces to move the carrier. However, Applicant's point out that the robot is moved about within a library system and states the trait as being provided in the **presently pending invention**. (emphasis added) This is a feature that is not within the limitations of the claim language. Applicant is arguing an aspect of the disclosure of the instant invention. Further, Applicant argues that Miyoshi does not teach "an automated library system having at least one robot, a secondary coil disposed on each of the at least one robots respectively and positioned to inductively couple at least a portion of an alternating current in at least one primary coil to the at least one robot, and the at least one robot comprises a drive mechanism **configured to move the robot** about within the automated library system, **as set forth in the presently pending independent claims**. (emphasis added)" Again, this feature is not included in the claimed limitations. Nowhere in the instant claims is the "configuration of movement" of the robot claimed. Only a drive mechanism used to move the robot is broadly claimed. Once more, Applicant is arguing an aspect that has not been claimed.

Applicant continues by arguing that the patented invention of Heidelberg does not teach "a robot comprising a drive mechanism **configured to move** the robot about within an automated library system

as provided in **the presently pending invention.** (emphasis added)" Yet again, Applicant is arguing an unclaimed feature and an aspect of the disclosure of the instant invention.

In addition, Applicant paraphrases Heidelberg's abstract as teaching linear acceleration. Also stating that "one of ordinary skill ... would understand that the rotor taught by Heidelberg is a driven element (i.e., a mechanism driven by a magnetic field)." Examiner agrees that skilled artisans would recognize the rotor as a driven element and refers to Heidelberg's disclosure at col. 1, ll. 1-15. Furthermore, skilled artisans would also recognize that "a mechanism driven by a magnetic field" is, as by definition, mutual inductance. As best understood by the interpretation of the instant claims, Applicant claims the movement of the robot by inductive force. This is clearly taught by Heidelberg and Miyoshi.

Lastly, Applicant argues the cited references of prior art individually as not teaching the limitations of the instant invention. The combination of Miyoshi in view of Heidelberg was used to reject instant claims 1-21 because the merging of each of their patented inventions teaches the claimed limitations of the instant invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Art Unit: 2125**

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (703) 305-9766. The examiner can normally be reached Tuesday - Thursday from 9:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (703) 308-0538.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

**(703) 872-9306 for Official Communications**

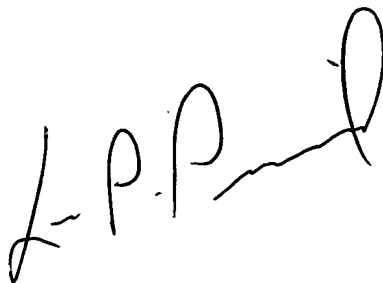
hand-delivered responses should be brought to:

**Receptionist - Sixth Floor  
Crystal Park II, 2121 Crystal Drive, Arlington, Virginia**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Sheela S. Rao  
April 19, 2004



**LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**